

REMARKS

Claims 1-13 are all the claims pending in the application. New claim 13 has been added to further define the invention. Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

Formal Matters

The Examiner has not returned initialed and signed copies of the Forms PTO 1449 submitted on June 17, 2002 and September 28, 2001 in this application. Applicants respectfully request that the Examiner return initialed and signed copies of these forms with the next Office Action.

The title of the invention was objected to as being not descriptive. Applicants have amended the title in a manner believed to overcome this objection.

Claim Rejections - 35 U.S.C. § 102/103

1. Claim 1

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,683,390 ("Imori"). Applicants respectfully traverse this rejection because Imori fails to disclose every element as set forth and arranged in Applicants' claim.

The Examiner bears the initial duty of supplying the factual basis supporting a rejection by anticipation and the courts have interpreted this initial duty as placing on the Examiner the burden of presenting a prima facie case of anticipation.¹ An anticipation rejection under 35 U.S.C. § 102(b) "requires the disclosure in a single prior art reference ... of each and every element of the claim under consideration."² Further the Federal Circuit has determined that "[a]nticipation requires the presence in a single prior art reference ... of each and every element

¹ *In re Skinner*, 2 USPQ 2d 1788, 1788-89 (B.P.A.I. 1986).

² *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

of the claimed invention, arranged as in the claim.”³ This 102(b) anticipation rejection is improper because not every element of Applicants’ claim 1 is present in the prior art reference (Imori).

The Examiner makes contradicting arguments that, standing alone, do not establish a prima facie case of anticipation. In the Examiner’s DETAILED ACTION on pages 2-3, paragraph 4, the Examiner first says that Imori illustrates “an insulating bush (8)... with **the bush (heat sink [of Imori]) (2)** located between the **insulating bush (annular insulator) (8)** and the connecting terminal....” The Examiner then confusingly switches and states that “the connecting terminal (terminal member) (11) placed between the **bush (annular insulator) (8)** and the fastening nut (9).” Thus, the Examiner asserts that Imori’s annular insulator (8) is both an insulating bush and a bush. But Applicants’ insulating bush 41 and bush 43 are distinct entities as are the heat sinks 2 and annular bushing 8 of Imori. Therefore, because the Examiner has interchangeably confused these elements with each other, he has not made out a proper case of anticipation.

2. Claims 2, 7 and 11

Claims 2, 7, and 11, were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Imori and further in view of J.P. Patent Application 03150010A (“Kusumoto”).

First, the Examiner repeats the improper interchange of the Imori terms in paragraphs 6, 11, 16, 23, and 30 of the Office Action. Accordingly, Applicants contend that Examiner has failed to establish *prima facie* obviousness of claims 2, 7, and 11.

Second, this rejection is improper because the cited references fail to teach or suggest all the elements of the Applicants’ claimed invention, and the Examiner appears to be reading the Applicants’ own invention into the prior art.

³ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

The mere fact that prior art may be modified to reflect features of a claimed invention is not enough to establish prima facie obviousness under 35 U.S.C. §103.⁴ In a combination of cited references, there must be a suggestion of motivation, or desirability, of the changes suggested by the Examiner.⁵ There must be a motivation in the cited prior art combination of references, under 35 U.S.C. §103, to arrive at the Applicants' invention without a hindsight analysis by reading the Applicants' own invention into the prior art.⁶

This rejection under 35 U.S.C. §103 is improper since the cited art references fail to disclose or teach all the elements of the Applicants' claimed invention, and the Examiner appears to be reading the Applicants' own invention into the prior art. In the Examiner's DETAILED ACTION on page 4, paragraph 6, the Examiner states that "Imori et al. Illustrates an annular insulator (8), which acts as a **fixed part fixed** to the output terminal bolt (output terminal member) (11)" (emphasis added). Imori does NOT state or imply that the annular insulator (8) is "fixed" to the output terminal bolt. The only language in Imori that one could possibly construe to be similar is in the Background of the Invention where Imori states that "[a]n output terminal 7 in the form of a threaded bolt is firmly attached to the plus side (the upper side in FIG. 4) of the pair of heat sinks 2," and in Imori's claims 1 and 5 that state "an axial output terminal member connected to the rectifier." However, these heat sinks 2 of Imori serve the same function as the Applicants' cooling plate 22 and the insulating bush 27, wherein the positive electrode side diodes 20 are mounted on the cooling plate 22. Applicants' bush 43 is a separate entity that performs a completely unique function.

Thus, the only fixation to the output terminal bolt that Imori suggests is what the Applicants have already disclosed in the Background of the Invention, namely in Applicants' FIG. 7, the cooling plate 122 with flange part 130 is "attached" to the output terminal bolt 26 in

⁴ *In re Fritch*, 23 USPQ2d 1780.

⁵ *Id.*

⁶ *In re Deminski*, 230 USPQ 313.

the vicinity of hole 134. However, Applicants' bush 43 is not taught or suggested by any structure cited by the Examiner in the prior art.

The Examiner admits that Imori does not disclose a bushing part that is loosely fitted onto the terminal bolt and proposes that Kusumoto discloses a bushing (insulator) (10) that is secured to the output terminal bolt (11). (Office Action, pgs 4-5). Kusumoto is directed to an insulating bush and not to Applicants' bush 43, 45 that is intended to absorb and transfer mechanical energy. Furthermore, Kusumoto's insulator (10) is directed to the loose fit between the insulating bush and the housing, not to the loose fit between the bush and the output terminal as set forth in Applicants' claims.

Thus, Imori does not teach or suggest a bush fixed to an output terminal bolt on the opposite side of the vehicle side connecting terminal. Kusumoto does not teach or suggest a bush fixed to an output terminal bolt nor a bushing part loosely fitted onto the output terminal bolt. Therefore, *arguendo*, even assuming that one of ordinary skill in the art were motivated to combine Imori and Kusumoto as suggested by the Examiner, any such combination would still not teach or suggest the bush, as set forth in all of Applicants' claims, 2, 7 and 11. Accordingly, claims 2, 7 and 11 are not rendered obvious by Imori and Kusumoto.

Further, the Examiner states the "an annular insulator (8) acts as a fixed part". However, claim 2 sets forth that "the bush has ... a fixed part" and claim 1 also sets forth that "a bush is provided between the insulating bush and the vehicle side connecting terminal". Thus, since Imori does not teach or suggest that the annular insulator (8) is provided between the insulating bush and the vehicle side connecting terminal, the annular insulator (8) of Imori does not correspond to the bush as claimed by Applicants. Furthermore, even if the annular insulator (8) of Imori acts as a fixed part, the Examiner's rejection relying upon this element is improper.

3. Claims 3 and 12

Claims 3 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Imori and further in view of U.S. Patent 4,232,238 ("Saito") and J.P. Patent Application 03150040A ("Kusumoto").

Because this rejection is based primarily upon Imori and Kusumoto, discussed in detail above, Applicants' previous arguments are incorporated herein by reference.

Further, the structure of Imori identified by the Examiner as a "cylindrical projecting part formed on a bracket (1) having a first opening (BB)" is actually an air regulating plate 6 and the Examiner's proposed opening (BB) is a component of said air regulating plate 6; it is not identical to the cylindrical projecting part claimed by the Applicants that surrounds the first opening and further has a second opening at the projecting end.

4. Claims 4 - 10, 5 - 8, and 6 - 9

Claims 4 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Imori and further in view of U.S. Patent 4,492,885 ("Kitamura") and U.S. Patent 4,843,267 ("Kaneyuki") and U.S. Patent 6,121,699 ("Kashihara") and Saito. Additionally, claims 5 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Imori and further in view of Kusumoto and Kitamura and Kaneyuki and Kashihara. Further, claims 6 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Imori and further in view of Saito and Kusumoto and Kitamura and Kaneyuki and Kashihara.

Because these rejections are based upon Imori and various secondary, tertiary, etc. references, Applicants' arguments as set forth above are pertinent and, therefore, are incorporated herein by reference.

Conclusion

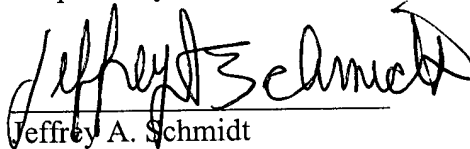
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111
Appln No. 09/964,734

Atty. Docket: Q66051

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeffrey A. Schmidt", written over a horizontal line.

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